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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590

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EXAMINER

HAMILTON, ISAAC N

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,015

Applicant(s)

VEGLIANTE ET AL.

Examiner

Isaac N Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) 11, 19, 23, 26, 34, 37 and 39 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04-12-02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 06. 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because figure 1 has several lead lines with no reference numbers; figure 2 has several reference numbers that are cut-off on the left side of the drawing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 39 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 39 is not consistent with independent claim 24 with respect to their preambles, if intended to be dependent on claim 24.

3. Claims 11, 19, 23, 26, 34 and 37 are objected to because of the following informalities: "said upper portion of said blade housing said blade" should be changed to --said upper portion of said blade housing houses said blade--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 24 recite the limitation "said at least one rails" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claims 17, 20, 21, 24, 32, 35, 36 and 39 recite the limitation "said rails". There is insufficient antecedent basis for this limitation in the claim.

Claims 21 and 36 recite the limitation "said elongated rail base" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claims 22 and 38 recite the limitation "at least one rail" in line 7 and 5, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claims 23, 37 recite the limitation "said protrusion" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 39 recites the limitation "said step of molding an elongated base and molding a pair of rails" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 9, the phrase "about" in line 2 renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4, 5, 7, 20, 24, 35 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh et al (4,197,774), hereafter Singh, in view of Park et al (5,768,968), hereafter Park. Singh discloses film cutter apparatus 10; rail base 18; rail 24; blade housing 20; blade 56 and 58. Singh does not disclose a first material having attractive properties. However, Park teaches a first material having attractive properties in column 2, lines 44-47. It would have been obvious to provide a first material having attractive properties in Singh as taught by Park in order to provide a film grasping mechanism that does not damage or change the surface texture of the film.

Regarding claims 4 and 5, Singh discloses everything as noted above, but does not teach a first material that is smooth and non-porous. However, Park teaches a first material 34 that is smooth and non-porous in figure 2. It would have been obvious to provide a first material that is smooth and non-porous in Singh as taught by Parks in order to provide a film grasping mechanism that does not damage or change the surface texture of the film.

Regarding claims 7 and 39, coextrusion is a well known method of manufacturing parts. It would have been obvious to manufacture parts for the apparatus using extrusion in order to automate the manufacturing process.

Regarding claims 10-13, 26, 27 and 28, note in Singh channel 22; upper portion 44; lower portion and tracking device 48. Note figure 3.

Regarding claims 14 and 29, note in Singh tubular shape of lower portion 48 juxtaposed between 48 and 42; tubular shape of channel 42 and 26 in figure 2.

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- Regarding claim 38, note injection molding in column 3, line 60 through column 4, line 3.
8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Singh and Parks as applied to claim 1 above, and further in view of Fish (4,196,647). The combination discloses everything as noted above, but does not disclose providing a positive charge to the film. However, Fish teaches providing a positive charge to the film in column 1, lines 14-19. It would have been obvious to provide a positive charge to the film in the combination as taught by Fish in order to provide a film grasping mechanism that does not damage or change the surface texture of the film. It is noted that static forces can supply a positive charge.
9. Claims 3, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Singh and Parks as applied to claim 1 above, and further in view of Johnson (5,022,154). The combination discloses everything as noted above, but does not disclose a first material of Shore A and does not disclose a material having a durometer in the range of 1 to 200. However, Johnson teaches a first material of Shore A and a material having a durometer in the range of 1 to 200 in the Abstract. It would have been obvious to provide a first material of Shore A and a material having a durometer in the range of 1 to 200 in order to provide a material that is electrostatically active.
10. Regarding claims 6, 10, 15, 16, 25, 30 and 31, the combination of Singh and Park discloses the claimed invention except for the following materials: rigid vinyl, PVC, plastic, rubber, vinyl, glass, silicon, metal, acetal, sensitive adhesive, adhesive, natural rubber, rubber and rubber cement. It would have been obvious to one having ordinary skill in the art at the time

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the invention was made to provide these materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

11. Claims 17 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Singh and Park as applied to claim 1 above, and further in view of Wilson et al (3,552,614), hereafter Wilson. The combination discloses everything as noted above, but does not disclose an adhesive layer. However, Wilson teaches an adhesive layer in column 3, lines 44-45. It would have been obvious to provide an adhesive layer in the combination as taught by Wilson in order to secure the apparatus to a box of film or sheet material.

12. Claims 18, 19, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Singh and Park as applied to claim 1 above, and further in view of Keene et al (3,277,760), hereafter Keene. The combination discloses everything as noted above, but does not disclose a blade housing that snap fits into a protrusion. However, Keene teaches a blade housing 45 that snap fits into a protrusion 26 and 27. It would have been obvious to provide a blade housing that snap fits into a protrusion in the combination as taught by Keene in order to automate the cutter movement using pneumatic pressure.

13. Claims 21 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh in view of Park and Wilson. Singh discloses rail 24; blade housing 20; blade 56 and 58. Singh does not disclose a first material having attractive properties and does not disclose an adhesive layer. However, Park teaches a first material having attractive properties in column 2, lines 44-47 and Wilson teaches an adhesive layer in column 3, lines 44-45. It would have been obvious

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to provide a first material having attractive properties in Singh as taught by Park in order to provide a film grasping mechanism that does not damage or change the surface texture of the film. It would have been obvious to provide an adhesive layer in Singh as taught by Wilson in order to secure the apparatus to a box of film or sheet material.

14. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singh in view of Fish. Singh discloses rail base 18; pair of rails 24; blade housing 20; blade 56 and 58. Singh does not disclose a material that provides a positive charge. However, Fish teaches a material that provides a positive charge in column 1, lines 15-19. It is noted that static forces can supply a positive charge.

15. Claims 23 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh in view of Park and Keene. Singh discloses rail base 18; pair of rails 24; blade housing 20; blade 56 and 58; upper portion 44; lower portion 48. Singh does not disclose a first material having attractive properties and does not disclose an adhesive layer and does not disclose a blade housing that snap fits into a protrusion. However Park teaches a first material having attractive properties in column 2, lines 44-47 and Keene teaches Keene teaches a blade housing 45 that snap fits into a protrusion 26 and 27. It would have been obvious to provide a first material having attractive properties in Singh as taught by Park in order to provide a film grasping mechanism that does not damage or change the surface texture of the film. It would have been obvious to provide a blade housing that snap fits into a protrusion in the combination as taught by Keene in order to automate the cutter movement using pneumatic pressure.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Welsch is cited for providing electrostatic charges to paper sheets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 703-305-4949. The examiner can normally be reached on Monday thru Friday between 8am and 5pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

IH

December 26, 2002


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Supervisory Patent Examiner
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